

Petition for Official Interpretation of the Rules and MPEP Provisions

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Dated: September 7, 2011

Electronic Signature for Nicole R. Pruett: /Nicole R. Pruett/

Docket No.: 4967.012
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Toshiaki Kawakami

Application No.: 09/901,359

Confirmation No.: 5346

Filed: July 9, 2001

Art Unit: 3751

For: SEAT SUPPORTING TABLE FOR A
BARBER OR BEAUTY CHAIR AND HAIR
WASHER WITH THE SEAT SUPPORTING
TABLE

Examiner: C. R. Eloshway

**PETITION FOR OFFICIAL INTERPRETATION OF THE RULES AND MPEP
PROVISIONS**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Please see **REMARKS** which begin on page 2 of this paper.

REMARKS

This Petition is filed responsively to a suggestion included in a Petition decision dated July 7, 2011 in the present matter.

In the present matter, the patentee properly filed an Information Disclosure Statement (IDS) on May 24, 2002 according to MPEP provisions in effect at the time. At the time of filing of the May 24, 2002 IDS a dated copy of a communication from a foreign patent office could be submitted in satisfaction of the requirement for a statement under 37 CFR § 1.97(e). Applicant filed a Certificate of Correction dated October 11, 2007 so that the patent record reflected consideration of the properly filed Information Disclosure Statement dated May 24, 2002. This certificate was granted in the Certificate of Correction dated December 11, 2007. However, the December 11, 2007 Certificate was nullified by a new Certificate of Correction dated April 29, 2008. Applicant in a Petition dated May 16, 2008 petitioned for vacating the April 29, 2008 Certificate. After nearly three years of delay, the Office of Petitions in a decision dated February 15, 2011 denied the May 16, 2008 Petition, determining that simply because the phrase “required communication” in MPEP § 609 (August 2001) does not literally and *verbatim* reference 37 C.F.R. § 1.97 (e) it *per se* follows that the phrase cannot be interpreted to refer to a statement under 37 CFR § 1.97 (e).

Applicant filed a Request for Reconsideration, dated April 15, 2011 in view of the February 15, 2011 decision. In response to that Request, the Office of Petitions suggested that Applicant file the present Petition seeking an official interpretation of the phrase “required communication” in MPEP § 609 (August 2001).

The Denial of applicant’s May 16, 2008 Petition was based on the finding by the Office of Petitions, after nearly three years of consideration, that simply because the phrase “required communication” in MPEP § 609 (August 2001) does not literally and *verbatim* reference “1.97(e)” it *per se* follows that the phrase cannot be interpreted to refer to a statement under 37 CFR § 1.97(e):

The portion of the MPEP that petitioner referenced does not state that the submission of a dated copy of the foreign office communication will be considered as satisfying the 1.97(e) statement. The language in that paragraph of the MPEP states that "the copy will be accepted as the required communication." Note that it does not state that the copy will be accepted as the required 1.97(e) statement. Since applicant failed to submit the 1.97(e) statement as required by the rule, the examiner was correct in refusing to consider the cited prior art references DE 3522110 A1 in the IDS filed on June 11, 2002." See *Decision on Petition*, dated February 15, 2011.

The Paragraph of Interest in MPEP § 609 (August 2001) (hereinafter, the "Paragraph of Interest") is as follows:

If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date on the communication, the copy will be accepted as the required communication. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

Petitioner respectfully asserts the phrase "required communication" in the paragraph at issue of MPEP § 609 (August 2001) cannot reasonably refer to any item other than a required statement under 37 CFR § 1.97(e).

First, the term "communication" is not inconsistent with the term "statement." All "statements" are "communications," "communication" being a term that is generical for and in some instances synonymous with the term "statement." Accordingly, the reference to "communication" does not negate the interpretation of the term "communication" as a type of "statement."

Further, the term "required" in the phrase "required communication" reinforces the conclusion that "required communication" refers to a statement under 37 CFR § 1.97(e). Previously in MPEP § 609 (August 2001), forms of the term "required" are used in connection with 37 CFR § 1.97. See *e.g.*, p. 600 -123, to 600-124 of MPEP § 609 (August 2001), "the requirements based on the time when the information disclosure statement is filed are summarized as follows...37 CFR § 1.97 requirements"; p. 600-125 of MPEP § 609 (August 2001), "the requirements of 37 CFR § 1.97 provide for consideration by the Office of Information which is submitted within a reasonable time, *i.e.*, within 3 months...".

In addition, the Paragraph of Interest makes reference to a “three month period” and a “dated” communication. Previously in MPEP § 609 (August 2001), a three month period is referenced only in connection with 37 CFR § 1.97(e). Thus, the reference to a “three month period” undeniably links the Paragraph of Interest to 37 CFR § 1.97(e). There is no rational explanation for the reference to “a three month period” and a “dated” communication in the Paragraph of Interest unless the Paragraph of Interest is understood to provide the rule that a copy of a properly dated foreign Office action satisfies the requirements of 37 CFR § 1.97(e) and particularly 37 CFR § 1.97 (e)(1).

If the Office wishes to maintain its position that the Paragraph of Interest does not provide that a properly dated copy of a foreign Office action satisfies requirements under 37 CFR § 1.97(e), the Office is respectfully requested to set forth a rational explanation for the reference to “a three month period” and a “dated” communication in the Paragraph of Interest that is contrary to the conclusion that a properly dated copy of a foreign Office action satisfies requirements of 37 CFR § 1.97(e) and particularly 37 CFR § 1.97 (e)(1).

Still further, the Paragraph of Interest includes the noted sentence “it will be assumed in the absence of evidence to the contrary, that the communication was for a foreign counterpart application.” The noted sentence is a specific reference to particular statement requirements of 37 CFR § 1.97(e)(1) which references “each item... in a counterpart foreign application...”.

Thus, the reference to a “counterpart foreign application” in the Paragraph of Interest undeniably links the Paragraph of Interest to 37 CFR § 1.97(e). There is no rational explanation for the reference to a “counterpart foreign application” in the Paragraph of Interest unless the Paragraph of Interest is understood to provide that a copy of a properly dated foreign Office action satisfies requirements of 37 CFR § 1.97(e) and particularly 37 CFR § 1.97 (e)(1).

If the Office wishes to maintain its position that the Paragraph of Interest does not provide that a properly dated copy of a foreign Office action satisfies requirements under 37 CFR § 1.97(e), the Office is respectfully requested to set forth a rational explanation for the reference to a “counterpart foreign application” in the Paragraph of Interest that is contrary to the conclusion that a properly dated copy of a foreign Office action satisfies requirements of 37 CFR § 1.97(e) and particularly 37 CFR § 1.97 (e)(1). The Office is also respectfully requested to set forth a rational explanation as to why it would be necessary or logical to apply the assumption that a “communication” is from a “counterpart foreign application” if the conclusion that the Paragraph of Interest provides that properly dated foreign Office action satisfies requirements under 37 CFR § 1.97(e) and particularly 37 CFR § 1.97(e)(1) is not correct.

That the Paragraph of Interest specifies activity that will be taken to be in satisfaction of 37 CFR § 1.97(e)(1) is still further reinforced by viewing the Paragraph of Interest in combination with the paragraph that ensues the Paragraph of Interest (the Ensuing Paragraph). The Paragraph of Interest in combination with the Ensuing Paragraph reads as follows:

MPEP § 609

If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date on the communication, the copy will be accepted as the required communication. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

In the alternative, a statement can be made if no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the statement after making reasonable inquiry, neither was it known to any individual having a duty to disclose more than 3 months prior to the filing of the statement. MPEP § 609, 600-129.

It is seen that the two paragraph combination noted above in MPEP § 609 (August 2001) precisely parallels in structure of the two paragraph combination of 37 CFR § 1.97(e)(1) and 37 CFR § 1.97(e)(2).

37 CFR §1.97(e)

(1) that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement, or

(2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the statement.

The structural parallels between the noted section of MPEP § 609 (August 2001) and 37 CFR § 1.97(e) further renders inescapable the conclusion that a properly dated copy of a foreign Office action satisfies requirements under 37 CFR § 1.97 (e) and particularly 37 CFR § 1.97 (e)(1). The Office's attention is directed to the linguistic similarity between the Ensuing Paragraph and 37 CFR § 1.97(e)(2) in connection with the symmetry between the "either...or" language of 37 CFR § 1.97(e) and the "alternating" language of MPEP § 609 (August 2001).

If the Office wishes to maintain its position that the Paragraph of Interest does not provide the rule that a properly dated copy of a foreign Office action satisfies the requirements of 37 CFR § 1.97(e) and specifically 37 CFR § 1.97 (e)(2) the Office is respectfully requested to provide an explanation for the presence of the term "alternatively" in the Ensuing Paragraph that is both contrary to the conclusion that the Paragraph of Interest and 37 CFR § 1.97(e)(1) are logically linked and contrary to the conclusion that the Paragraph of Interest describes activity in satisfaction of the requirements of 37 CFR § 1.97(e) and particularly 37 CFR § 1.97 (e)(1).

In addition, the entirety of the content of Petitioner's Petition dated May 16, 2008, is set forth herein (incorporated by reference). Also incorporated by reference are: Petitioner's concurrently filed Request for Reconsideration dated September 7, 2011, Petitioner's Request of April 15, 2011, Petitioner's Response under 37 CFR § 1.322 dated February 12, 2007, as well as Petitioner's Request for Certificate of Correction dated October 11, 2007.

In view of the above, Petitioner respectfully Petitions that the phrase “required communication” of MPEP §609 (August 2001) be accorded by the Office the official interpretation as referring to 37 CFR § 1.97 (e).

Petitioner believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-1935.

Dated: September 7, 2011

GB/nrp

Respectfully submitted,
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